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OFFICE OF PETITIONS

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In re Patent No. 7,395,503 : ON PETITION
Pravetz : under 37 CFR 1.183
Issue Date: July 1, 2008 :
Application No. 10/072,382 : and
Filed: February 6, 2002 :
Attorney Docket No. 07844- : ON REQUEST FOR RECONSIDERATION
494001 : OF PATENT TERM ADJUSTMENT

This is a decision on the petition under 37 C.F.R. 1.183, requesting that the Office suspend the rules and consider on the merits a Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) filed more than two months from the date the above-referenced patent issued and on the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d), both of which were filed on December 22, 2008.

The petition under 37 CFR 1.183 is **dismissed**.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **dismissed as untimely filed**.

Any request for reconsideration, whether directed to the decision on petition under 37 CFR 1.183 or to the decision on application for patent term adjustment under 37 CFR 1.705(d), must be filed within two months of the mailing date of this decision. Extensions of time under 37 CFR 1.136 are not permitted. See § 1.181(f).

BACKGROUND

On July 1, 2008, the above-identified application matured into U.S. Patent No. 7,395,503, with a revised patent term adjustment of 553 days. No request for reconsideration of the patent term adjustment indicated in the patent was filed within two months of the date the patent issued. Patentee now petitions under 37 C.F.R. § 1.183 to (i) suspend or waive the requirement of 37 C.F.R. § 1.705(d) that a Request for Reconsideration of Patent Term Adjustment be filed within two months of the date the patent issued; and (ii) consider the enclosed Request for Reconsideration of Patent Term Adjustment. Patentee makes this request, in view of the "exceptional" situation presented by the recent decision in *Wyeth v. Dudas*, No. 07-1492 (D.D.C. Sept. 30, 2008).

**ON PETITION UNDER 37 CFR 1.183
TO WAIVE THE TWO-MONTH REQUIREMENT OF 37 CFR 1.705(d)**

The above-referenced patent issued on July 1, 2008. A request for reconsideration of the patent term adjustment indicated in the patent was not filed until December 22, 2008. Petitioner requests that the Office suspend the rules and consider on the merits the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) even though it was untimely filed more than two months from the date the patent issued.

The relevant regulation, 37 CFR 1.705(d), provides that:

If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, *any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued* and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues. (*emphasis added*).

By the express provisions of 37 CFR 1.705(d), a request for reconsideration of patent term adjustment must be filed within two months of the date the patent issued. It is undisputed that no such request for reconsideration was filed by September 1,

2008, the date two months from the date this patent issued, July 1, 2008. Rather, on December 22, 2008, nearly three months after the issuance of a decision in Wyeth v. Dudas on September 30, 2008, petitioner filed the instant request for waiver of the two-month requirement.

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

Preliminarily, it is recognized that the two-month requirement of 37 CFR 1.705(d) is a requirement of the regulations and not a statutory requirement. The statute, 35 U.S.C. 154, requires the Office to provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director. But, the statute allows the Director to establish the procedures for requesting such reconsideration. Those procedures¹ include pursuant to 37 CFR 1.705(d) setting a two-month period for filing a request for reconsideration of the revised patent term adjustment indicated in the patent. As

¹ 35 U.S.C. § 154(b)(3) provides that the USPTO shall: (1) prescribe regulations establishing procedures for the application for and determination of patent term adjustments under 35 U.S.C. § 154(b); (2) make a determination of any patent term adjustment under 35 U.S.C. § 154(b) and transmit a notice of that determination with the notice of allowance under 35 U.S.C. § 151; and (3) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination. Pursuant to the mandate and authority in 35 U.S.C. § 154(b)(3), the USPTO promulgated 37 C.F.R. § 1.705, which provides that: (1) the notice of allowance will include notification of any patent term adjustment under 35 U.S.C. § 154(b) (37 C.F.R. § 1.705(a)); (2) any request for reconsideration of the patent term adjustment indicated in the notice of allowance (except as provided in 37 C.F.R. § 1.705(d)) must be by way of an application for patent term adjustment filed no later than the payment of the issue fee and accompanied by (inter alia) the fee set forth in 37 C.F.R. § 1.18(e) (37 C.F.R. § 1.705(b)); and (3) if the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued.

such, it is within the Director's authority to waive the two-month requirement.

Having considered petitioner's arguments, it is concluded that waiver of the two-month requirement is not warranted. The primary basis for requesting waiver set forth by petitioner is the "exceptional" situation presented by the recent decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. Sept. 30, 2008).

Specifically, petitioner states that in Wyeth, the U.S. District Court for the District of Columbia held that contrary to USPTO practice, a patentee is entitled to Patent Term Adjustment credit for examination delay under 37 CFR 1.702(b) in addition to any examination delay under 37 CFR 1.702(a), to the extent that the two periods of delay "do not occur on the same calendar day or days." Petitioner argues that they could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date the above-referenced patent issued because the basis for the Request for Reconsideration of Patent Term Adjustment is the Wyeth decision, which was entered more than two months after the issuance of their patent.

First, of all, the issuance of the Wyeth Opinion is not an extraordinary situation. Wyeth followed the procedure set forth in 37 CFR 1.705 for requesting reconsideration of the patent term adjustment determination. Then, pursuant to 35 U.S.C. 154(b)(4)(A)², Wyeth timely filed a complaint in District Court seeking judicial review of the Office's decision. A Memorandum Opinion and Order, the Wyeth decision of September 30, 2008, directed to the parties involved was issued.

The fact that any relief ultimately granted in Wyeth would benefit patentee had they timely filed a request for reconsideration does not make the situation extraordinary. Petitioner chose not to challenge their revised patent term adjustment within the two-month period. Petitioner's argument that they could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date the above-referenced patent issued because the basis for the Request for

² 35 U.S.C. 154(b)(4)(A) APPEAL OF PATENT TERM ADJUSTMENT DETERMINATION.
- (A) An applicant dissatisfied with a determination made by the Director under paragraph (3) shall have remedy by a civil action against the Director filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent. Chapter 7 of title 5 shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the Director, and the Director shall thereafter alter the term of the patent to reflect such change.

Reconsideration of Patent Term Adjustment is the Wyeth decision, which was entered more than two months after the issuance of their patent, is not compelling. Petitioner could have filed a Request for Reconsideration of Patent Term Adjustment as Wyeth did. It is acknowledged that petitioner may have chose not to file a request for reconsideration based on a conclusion that the Office's interpretation of 35 U.S.C. § 154(b)(2)(A) was correct. Nonetheless, the fact that the District Court has now issued an Opinion contrary to the Office's interpretation does not make the situation extraordinary. This is not unlike any other situation where a patentee (or applicant) challenges a final agency decision and the decision upon judicial review could have had applicability to another patentee (or applicant) had they taken such action. In fact, many patentees may be in the same situation as petitioner with respect to the Wyeth decision.

The key consideration in determining whether waiver is warranted is whether the circumstance that led to petitioner failing to meet the two-month requirement was an extraordinary situation where justice requires waiver.

Petitioner simply fails to articulate how their failure to file a request for reconsideration of patent term adjustment within two months of the issue date of the patent was due to an extraordinary situation. Petitioner cannot rely on Wyeth's actions or the Wyeth decision to establish that their situation was extraordinary.

Moreover, justice does not require waiver of the two-month requirement. Justice requires that the Office continue to devote its resources to the adjudication of timely filed requests for reconsideration under 37 CFR 1.705(b) and (d). Further, upon ultimate resolution of the interpretation of 37 CFR 1.702, justice requires that the Office determine consistent with relevant law and practice, and appropriate Court or legislative guidance, the applicability of any changes as to all affected patentees who failed to timely seek administrative remedy, and thus, could not seek judicial review.

In addition, given that the law only allows 180-days for both the filing of a petition and for the Office's consideration of that petition petitioner's unexplained nearly two-three month delay, after the Opinion in Wyeth, in filing the petition weighs against them. The remaining period to file a civil action does not so distinguish petitioner's situation from any other patentee who failed to meet the two-month deadline for filing a

request for reconsideration of patent term adjustment determination such that justice requires waiver.

In view thereof, the petition under 37 CFR 1.183 for waiver of the two-month requirement of 37 CFR 1.705(d) is dismissed.

Accordingly, consideration now turns to the Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(d).

**ON REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)**

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)," filed December 22, 2008. Therein, patentee requests correction of the patent term adjustment (PTA) indicated in the patent to eight hundred fifteen (815) days.

On July 1, 2008, the above-identified application matured into U.S. Patent No. 7,395,503 with a revised patent term adjustment of 553 days. The instant request for reconsideration was filed more than five months after the issuance of the patent, on December 22, 2008.

No error in the printing of the patent has been shown. The patent term adjustment indicated on the patent reflects the Office's determination of patent term adjustment shown in the PAIR system for this application. 37 CFR 1.705(d) provides the sole avenue before the Office for requesting reconsideration of the Office's determination of patent term adjustment indicated in the patent. Moreover, § 1.705(d) states that "any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section." Since the request was not filed within two months of the issue date of the patent, the request is properly dismissed as untimely filed.

CONCLUSION

The request for waiver of 37 CFR 1.705(d) pursuant to 37 CFR 1.183 is not warranted. Accordingly, the request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) filed more than two months after the issue date of the patent is dismissed as untimely filed.

Telephone inquiries specific to this matter should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.

Kery A. Fries

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration

PTA Calculations for Application: 10/072382

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Number	Date	Contents Description	PTO	APPL	START
76.5	06/11/2008	PTA 36 MONTHS			
76	07/01/2008	PATENT ISSUE DATE USED IN PTA CALCULATION			
75	05/27/2008	EXPORT TO FINAL DATA CAPTURE			
74	05/16/2008	DISPATCH TO FDC			
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38	08/14/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
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27	10/26/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
26	11/02/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
25	10/26/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			

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24	10/24/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : James D. Pravetz
Patent No. : 7,395,503
Issue Date : July 1, 2008
Serial No. : 10/072,382
Filed : February 6, 2002
Title : DYNAMIC PREVIEW OF ELECTRONIC SIGNATURE APPEARANCE

Art Unit : 2178
Examiner : Kyle R. Stork
Conf. No. : 2559

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. §1.183 - 12/22/08

Assignee hereby petitions the Commissioner under 37 C.F.R. §1.183 for a suspension of 37 C.F.R. §1.705(d) and (e) and for acceptance of the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)," which is filed with this petition, to correct the erroneous patent term adjustment (PTA) calculation. Assignee may lose 262 days in the life of its patent through no fault of its own, seriously prejudicing Assignee in fully enforcing its statutory patent rights if this petition is not granted.

The above titled patent was issued on July 1, 2008. At the time of the issuance, the Office interpreted the law in a way that did not support correcting the PTA calculation. In fact, the applicant made an earnest attempt to follow the rules and law as have been set forth by the Office. On September 30, 2008, the U.S. District Court for the District of Columbia issued an opinion in *Wyeth v. Dudas* (*Wyeth et al. v. Jon W. Dudas*, U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), which made clear that the Office's method for calculating the PTA was in error. As a result of this change in the law, which occurred more than 2 months after the above entitled patent issued, petitioner could not reasonably have timely presented a request for reconsideration of the patent term adjustment.

This case presents the rare instance where the Office's application of the rules has been overturned by the courts. In such exceptional cases, it would be manifestly unjust to punish those who made an earnest attempt to comply with the laws and regulations as interpreted by the PTO.

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the United States Patent and Trademark Office using the EFS -WEB system on this date: December 22, 2008

Applicant : James D. Pravetz
Patent No. : 7,395,503
Issued : July 1, 2008
Serial No. : 10/072,382
Filed : February 6, 2002
Page : 2 of 2

Attorney's Docket No.: 07844-0494001 / P458

Please apply the \$400.00 fee required under 37 C.F.R. § 1.17(f) and any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: December 22, 2008

/Spencer C. Patterson/

Spencer C. Patterson

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : James D. Pravetz	Art Unit : 2178
Patent No. : 7,395,503	Examiner : Kyle R. Stork
Issue Date : July 1, 2008	Conf. No. : 2559
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Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

Applicant hereby petitions for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application. The Issue Notification mailed June 11, 2008 for the above-referenced application indicates that the Patent Term Adjustment at issuance is 553 days. Reconsideration of the Patent Term Adjustment calculation to increase PTO Delay from 661 days to 923 days, and to increase Total PTA from 553 to 815 days, is respectfully requested.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

- 1) The PTO mailed a delayed 14-month first non-final Office Action on January 26, 2005, thereby according a PTO Delay of 661 days. Applicant does not dispute herein this patent term adjustment calculation for this PTO "A Delay."
- 2) Applicant filed an Information Disclosure Statement on April 28, 2005 (received at the PTO on April 28, 2005). Applicant was accorded a delay of 2 days for a supplemental response. Applicant does not dispute herein this patent term adjustment for Applicant Delay.
- 3) Applicant filed a response to the third non-final Office Action on January 29, 2007 (received at the PTO on January 29, 2007). Applicant was accorded a delay

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the United States Patent and Trademark Office using the EFS -WEB system on this date: December 22, 2008

of 2 days for a late response. Applicant does not dispute herein this patent term adjustment for Applicant Delay.

- 4) Applicant filed a Notice of Appeal in response to the third final Office Action on July 9, 2007 (received at the PTO on July 9, 2007). Applicant was accorded a delay of 32 days for a late response. Applicant does not dispute herein this patent term adjustment for Applicant Delay.
- 5) Applicant filed an Amendment under 37 CFR 1.312 after the Notice of Allowance on April 21, 2008 (received at the PTO on April 21, 2008). Applicant was accorded a delay of 72 days for a submission after allowance. Applicant does not dispute herein this patent term adjustment for Applicant Delay.
- 6) The application was filed on February 6, 2002 and the patent issued on July 1, 2008, more than three years later. The earliest Request for Continued Examination was filed on October 26, 2005. No PTO Delay was for issuance of the patent after three years from filing. Applicant respectfully submits that the PTO's calculation of this PTO "B Delay" contains an error and that the correct PTO Delay for issuance beyond three years from filing is 262 days, as outlined further below.

REMARKS

Applicant has calculated the PTA in accordance with the clear intent of Congress. As outlined in *Wyeth v. Dudas* (*Wyeth et al. v. Jon W. Dudas*, U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that periods of time can "overlap" is if they occur on the same day, and if an "A delay" occurs on one calendar day and a "B delay" occurs on another, they do not overlap, and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. "A Delays" are defined as delays by the Office under 35 U.S.C. 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than 3-year application pendency.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, relies on the premise that the application was delayed under § 154(b)(1)(B) before the initial three-year period expired.

The Wyeth court determined that this construction cannot be squared with the language of § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years,” and that “B delay” begins once the PTO has failed to issue a patent within three years, not before.

In the current PTA calculation, the Office has only given credit for the larger of “A Delay” or “B Delay,” rather than the combined sum of “A Delay” and “B Delay” (which does not include any days after three years from filing where “A” and “B” delays overlap).

In this patent, “A Delay” should be calculated as 661 days and “B Delay” should be calculated as 262 days. Thus, the total PTO Delay should be calculated as 923 days.

In consideration of the events described above, Applicant believes the PTA calculation of 553 days is incorrect. As such, Applicant respectfully requests reconsideration of the patent term adjustment in the following manner:

- 1) Total PTO Delay should be calculated as 923 days;
- 2) Total Applicant Delay should be calculated as 108 days; and
- 3) Total PTA should be calculated as 815 days.

Applicant notes that this patent is not subject to a terminal disclaimer.

Applicant : James D. Pravetz
Patent No. : 7,395,503
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Filed : February 6, 2002
Page : 4 of 4

Attorney's Docket No.: 07844-0494001 / P458

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: December 22, 2008

/Spencer C. Patterson/
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